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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,617	11/24/2003	David M. Lowe	2003B125	4251
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EXXONMOBIL CHEMICAL COMPANY 5200 BAYWAY DRIVE P.O. BOX 2149 BAYTOWN, TX 77522-2149				
EXAMINER HAILEY, PATRICIA L				
ART UNIT PAPER NUMBER				
1755				

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,617

Applicant(s)

LOWE ET AL

Examiner

Patricia L. Hailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) 22-30 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

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Applicants' remarks and amendments, filed on May 2, 2005, have been carefully considered. No claims have been canceled or added; claims 1-30 remain pending in this application.

***Election/Restrictions***

1. Claims 22-30 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected process for selectively removing C<sub>2</sub> to C<sub>4</sub> alkynes or diolefins from a feedstock also containing olefins, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 14, 2004.

***Withdrawn Objections and Rejections***

The objection to the disclosure for having incomplete references to copending applications has been withdrawn in view of Applicants' insertion of the required serial numbers.

The provisional obviousness-type double patenting rejection of claims 1-5 and 8 as being unpatentable over claims 1, 10-13, and 18-25 of copending Application Serial No. 10/720,607, stated in the previous Office Action, has been withdrawn in view of the Terminal Disclaimer filed by Applicants on May 2, 2005.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Maintained Rejections***

***Claim Rejections - 35 USC § 103***

***3. Claims 1-16 and 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moser et al. (U. S. Patent No. 6,514,904).***

Moser et al. teach an alumina (col. 1, line 3 to col. 2, line 48) catalyst with a platinum group metal component (e.g., rhodium), incorporated therein via coprecipitation, ion exchange, or impregnation, using salts such as rhodium nitrate (col. 5, lines 39-40). See col. 5, lines 3-57 of Moser et al., especially lines 14-20, which discloses a platinum group component mass percentage range of about 0.01 to about 2%.

Moser et al. also disclose that the catalyst may contain optional modifiers such as indium, in amounts ranging from about 0.01 to about 5 mass %. See col. 6, lines 55-67 of Moser et al., which also discloses that the optional modifiers may be incorporated either during or after the preparation of the carrier material (i.e., alumina), or before, during or after the incorporation of the other catalyst components.

Because Moser et al. teach mass percentage ranges that read upon those respectively claimed, one of ordinary skill in the art would easily determine via known mathematic techniques that the molar ratios of platinum group component (e.g., rhodium), to modifier (e.g., indium) would read upon that respectively claimed.

In addition to the aforementioned preparation techniques, calcination and reduction steps are also employed. Calcination can be performed preferably before incorporation of any metals into the support, but also can be performed at temperatures ranging from about 370°C to about 600°C. See col. 7, lines 16-39 of Moser et al.

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The reduction step can be performed in a substantially water-free environment, and in the presence of gases such as hydrogen, nitrogen, or carbon monoxide, at temperatures ranging from about 315°C to about 650°C. See col. 8, lines 6-30 of Moser et al.

Moser et al. do not teach the exact percentage ranges for rhodium and indium, as recited in the instant claims. However, the percentage ranges taught by Moser et al. either are within or overlap the percentage ranges respectively recited in the instant claims.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. In re Malagari, 182 U.S.P.Q. 549.

Further, where claimed ranges “overlap or lie inside ranges disclosed by the prior art a prima facie case of obviousness exists.” In re Wertheim, 541 F.2d 257, 191 U.S.P.Q. 90 (CCPA 1976).

**4. *Claims 1-15 and 17-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (U. S. Patent No. 4,522,935).***

Robinson et al. teach a catalyst comprising a platinum group component, an indium component, and a porous support material, wherein the atomic ratio of indium to platinum group component is more than about 1.14. See col. 2, lines 26-35 of Robinson et al. Although this ratio is the reverse of that recited in Applicants' claims, one skilled in the art would easily deduce that inverting the atomic ratio of Robinson et al. would result in a ratio comparable to that claimed by Applicants.

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The platinum group component is present in an amount ranging from about 0.01 to about 5 wt. %, and the indium component is present in an amount ranging from about 0.01 to about 15 wt. %. See col. 3, lines 5-14 of Robinson et al. Examples of the platinum group component include rhodium. See col. 4, lines 20-34 of Robinson et al.

Both the platinum group component and the indium component may be incorporated into the support material via cogelation or coprecipitation with the support material, or by ion exchange or impregnation of the support material. With the indium component, compounds such as indium chloride or indium nitrate may be employed as impregnating solutions. See col. 4, lines 35-52 and col. 5, lines 10-46 of Robinson et al.

Examples of the support material include refractory oxides such as alumina and zirconium dioxide (zirconia). See col. 6, line 4 to col. 7, line 2 of Robinson et al.

In addition to the aforementioned methods of combining the catalyst components with the support material, techniques such as calcination and reduction are employed. Calcination temperatures range from about 700°F to about 1100°F (371.1°C to 593.3°C); reduction is performed under dry hydrogen at conditions including a temperature of about 400°F to about 1200°F (204.4°C to 648.8°C). See col. 7, line 50 to col. 8, line 19 of Robinson et al.

Robinson et al. do not teach the exact percentage ranges for rhodium and indium, as recited in the instant claims. However, the percentage ranges taught by Robinson et al. either are within or overlap the percentage ranges respectively recited in the instant claims.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range

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disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. In re Malagari, 182 U.S.P.Q. 549.

Further, where claimed ranges “overlap or lie inside ranges disclosed by the prior art a prima facie case of obviousness exists.” In re Wertheim, 541 F.2d 257, 191 U.S.P.Q. 90 (CCPA 1976).

### ***Response to Arguments***

In response to Applicants’ arguments that Moser et al. do not teach the claimed catalyst, it is the Examiner’s position that the claims in their present form, by reciting the term “comprising”, do not exclude the presence of additional components in either specified or unspecified amounts. Further, the distinct properties Applicants present as critical to the catalyst of Moser et al. does not mean that Patentees’ catalyst does not read upon that instantly claimed. In the Examiner’s broadest interpretation, Applicants’ claims call for (a) a rhodium component, and (b) an indium component. As addressed in the above discussion of Moser et al., both (a) and (b) are disclosed in Moser et al.

In response to Applicants’ arguments that the “inventive catalyst is significant for treating highly unsaturated materials (usually alkynes or diolefins) present as a small percentage of an olefin stream”, it is the Examiner’s position that this feature is an indication of intended use, and is not a feature recited in the instant claims. It is the claims that define the claimed invention, and it is claims, not specifications, that are anticipated or unpatentable. Constant v. Advanced Micro-Devices, Inc., 7 U.S.P.Q. 2d 1064.

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Applicants' claims in their present form are merely directed to a "catalyst composition". Any recitations regarding specific characteristics or intended uses are not given patentable weight.

With respect to Applicants' arguments regarding the skilled artisan's omission of "the shape criteria of Moser" and the exhaustive combination of elements in Moser et al., as calculated by Applicants, it is the Examiner's position that the "skilled artisan" need only select the components disclosed in Moser et al. that are also recited in Applicants' claims. Selection of any elements other than those recited by Applicants is unnecessary.

With respect to Robinson et al., Applicants argue that this reference does not provide the skilled artisan with any "indication of which chemicals to use to incorporate these elements, how to incorporate them, how much to incorporate, and which of the other components should be selected with them (or not)." The Examiner respectfully states that Applicants' claims in their present form do not recite specific chemicals, either. Phrases like "a rhodium compound" and "an indium compound" read on any and every compound known as sources for rhodium and indium useful in catalyst preparations. Further, as discussed above, Robinson et al. teach incorporation of the components into the support material via cogelation, coprecipitation, ion exchange, or impregnation. Although Robinson et al. provide a number of exemplary catalyst components, the components that are recited in Applicants' claims are the only components the skilled artisan needs to select to obtain Applicants' claimed catalyst.

For these reasons, Applicants' arguments are not persuasive.



***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

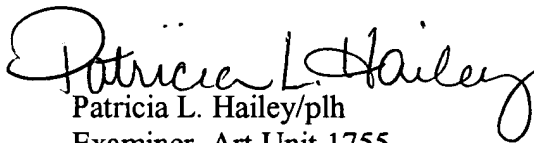
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

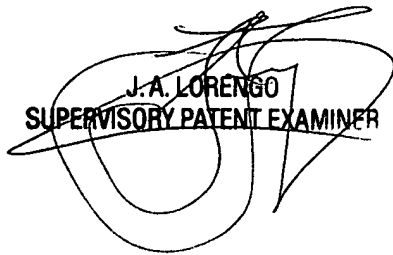
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
June 6, 2005

  
J.A. LORENZO  
SUPERVISORY PATENT EXAMINER